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FROM: Terry W. Kramer
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DATE: April 7, 2006

SUBJECT: U.S. Patent Application
Title: METHOD AND SYSTEM FOR TELEPHONICALLY
SELECTING, ADDRESSING, AND DISTRIBUTING
MESSAGES
Serial No.: 09/545,088
Attorney Docket No.: CGH 3001

PAGES: INCLUDING COVER PAGE (36)

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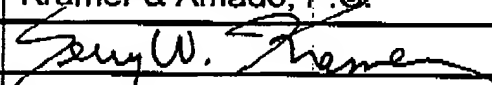
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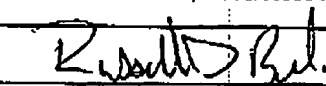
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| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 09/545,088 |
| | Filing Date | April 7, 2000 |
| | First Named Inventor | Charles G. Heisinger, Jr. |
| | Art Unit | 2162 |
| | Examiner Name | Fleurantin |
| Total Number of Pages in This Submission | 35 | Attorney Docket Number CGH 3001 |

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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant: : Charles G. Heisinger, Jr.
: :
For: : METHOD AND SYSTEM FOR
: : TELEPHONICALLY SELECTING,
: : ADDRESSING, AND DISTRIBUTING
: : MESSAGES
: :
Serial No.: : 09/545,088
: :
Filed : April 7, 2000
: :
Art Unit : 2162
: :
Examiner : Jean B. Fleurantin
: :
Attorney Docket No. : CGH 3001
: :
Confirmation No. : 1969

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief is submitted in response to the Notification dated February 13, 2006,
and the Office Action dated August 2, 2004.

I. REAL PARTY IN INTEREST

The real party in interest for this application is the Applicant and Appellant, Charles G.
Heisinger, Jr.

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Application No.: 09/545,088
Attorney Docket No.: CGH 3001

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 36-40, 44 and 47-64 are now pending, claims 36, 47, 56 and 57 being independent. Claims 1-35, 41-43, 45 and 46 have been previously canceled.

IV. STATUS OF AMENDMENTS

The AMENDMENT dated September 3, 2003 has been entered.

The AMENDMENT UNDER 37 C.F.R. §§ 41.33(a), 1.116 dated April 6, 2006 has not been acted upon by the Examiner.

Procedure on Appeal

A review of the subject file history indicates that a "Notice of Appeal" was not filed along with the Supplemental Appeal Brief dated November 1, 2004. The Office Action dated February 13, 2006 did not address the need for the Applicant to file a Notice of Appeal. In an effort to ensure completeness of the file history of the subject application, a Notice of Appeal is respectfully submitted herewith.

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention is a system and method for using a telephone and a code to either obtain information from a merchant or advertiser, or to order information or a product directly from a merchant or advertiser. One embodiment provides a method and system for telephonically selecting, addressing and distributing messages that uses an automatic process to handle the task of creating and sending a message to an address that is stored in a database. In one exemplary embodiment, the body of the message is identified through use of a key code, which is supplied by an advertiser or other promoter through a media channel, such as radio, TV or print. Where the message constitutes an order to purchase, the caller's payment information, such as a credit card number, may be transmitted as part of the message. See Application at page 3, lines 17-27.

Another embodiment provides a method and system of utilizing automatic phone number identification and entered code information for direct response purposes in mass-media advertising. See Application at page 3, lines 30-34.

Another embodiment provides a method for selecting, addressing and distributing an electronic message through the convenience and use of a telephone. See Application at page 4, lines 1-3.

Another embodiment provides a system and method that compares the ANI of an inbound telephone call with an address previously input by a user in a database through an Internet website. Specific stored messages are retrieved from a database by the user through the use of DTMF signals, such as those generated from a telephone keypad. Upon receiving a

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

DTMF signal with delivery information, the message is sent either via fax, email, postal mail, time-delayed voicemail, or stored on a data table that is accessible through a website, depending on the option specified by the user. Payment information, such as a credit card number, may be included with the message. See Application at page 4, lines 19-32.

Claim 36

Claim 36 sets forth a method of addressing an electronic message, comprising the steps of:

providing a first database containing stored telephone numbers and user addresses for each of the stored telephone numbers (e.g. FIG. 3B, data table #319, pg. 9, ln. 34 to pg. 10, ln. 8);

providing a second database containing identification codes and product information corresponding to each of the identification codes (e.g. FIG. 3C, data table #329, pg. 10, ln. 10-18);

receiving a telephone call (e.g. FIG. 4, #406, pg. 12, ln. 22-23) from a user including one of the identification codes (e.g. FIG. 3C, #330, pg. 12, ln. 33-34);

identifying the received telephone number from the telephone call (e.g. FIG. 4, #408, pg. 12, ln. 25-27);

retrieving the user address from the first database by comparing the received telephone number with the stored telephone numbers (e.g. FIG. 5, #508, pg. 13, ln. 9-13);

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

retrieving the product information corresponding to the received identification code (e.g. FIG. 5, #510, pg. 13, ln. 13-17);

addressing the electronic message according to the retrieved address (e.g. FIG. 5, #510, pg. 13, ln. 22-28); and

sending at least a portion of the retrieved product information via the electronic message, wherein the first and second databases are used to create the electronic message (e.g. FIG. 5, #510, pg. 13, ln. 22-28).

Claim 47

A system for addressing an electronic message (e.g. FIG. 1), comprising:

a first database (e.g. FIG. 1, #110, pg. 7, ln. 28-32) containing stored telephone numbers and user information corresponding to each of the stored telephone numbers (e.g. FIG. 3B, data table #319, pg. 9, ln. 34 to pg. 10, ln. 8);

a second database (e.g. FIG. 1, #110, pg. 7, ln. 28-32) containing identification codes and addressing information corresponding to each of the identification codes (e.g. FIG. 3C, data table #329, pg. 10, ln. 10-18);

a receiver for accepting a telephone call (e.g. FIG. 2, # 202, pg. 8, ln. 29-32) from a user including one of the identification codes (e.g. FIG. 3C, #330, pg. 12, ln. 33-34);

an ANI for identifying the received telephone number from the telephone call (e.g. FIG. 4, #408, pg. 12, ln. 25-27);

a processor (e.g. FIG. 2, #204, pg. 8, ln. 22-24); and

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

wherein the first and second databases are used to create the electronic message and the processor retrieves the user information from the first database by comparing the received telephone number with the stored telephone numbers (e.g. FIG. 5, #508, pg. 13, ln. 9-13), retrieves the addressing information corresponding to the received identification code (e.g. FIG. 5, #510, pg. 13, ln. 13-17), addresses the electronic message according to the retrieved addressing information (e.g. FIG. 5, #510, pg. 13, ln. 22-28), and sends at least a portion of the retrieved user information via the electronic message (e.g. FIG. 5, #510, pg. 13, ln. 22-28).

Claim 56

A method of addressing an electronic message, comprising the steps of:

providing a first database containing stored telephone numbers and corresponding payment instructions and user addresses (e.g. FIG. 3B, data table #319, pg. 9, ln. 34 to pg. 10, ln. 8);

providing a second database containing identification codes and addressing information corresponding to each of the identification codes (e.g. FIG. 3C, data table #329, pg. 10, ln. 10-18);

receiving a telephone call from a user including one of the identification codes (e.g. FIG. 3C, #330, pg. 12, ln. 33-34);

identifying the received telephone number from the telephone call using an ANI (e.g. FIG. 4, #408, pg. 12, ln. 25-27);

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

retrieving the user information from the first database by comparing the received telephone number with the stored telephone numbers (e.g. FIG. 5, #508, pg. 13, ln. 9-13);

retrieving the addressing information corresponding to the received identification code (e.g. FIG. 5, #510, pg. 13, ln. 22-28);

addressing the electronic message according to the retrieved addressing information (e.g. FIG. 5, #510, pg. 13, ln. 22-28); and

sending the payment instructions via the electronic message, wherein the first and second databases are used to create the electronic message (e.g. FIG. 5, #510, pg. 13, ln. 22-28).

Claim 57

A method of purchasing a product, comprising the steps of:

providing a first database containing stored telephone numbers and user information corresponding to each of the stored telephone numbers (e.g. FIG. 3B, data table #319, pg. 9, ln. 34 to pg. 10, ln. 8);

providing a second database containing identification codes and product information corresponding to each of the identification codes (e.g. FIG. 3C, data table #329, pg. 10, ln. 10-18);

receiving a telephone call from a user including one of the identification codes (e.g. FIG. 3C, #330, pg. 12, ln. 33-34);

identifying the received telephone number from the telephone call (e.g. FIG. 4, #408, pg. 12, ln. 25-27);

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

retrieving the user information from the first database by comparing the received telephone number with the stored telephone numbers (e.g. FIG. 5, #508, pg. 13, ln. 9-13);

retrieving the product information corresponding to the received identification code (e.g. FIG. 5, #510, pg. 13, ln. 13-17); and

purchasing the product based upon the user information retrieved from the first database and the product information retrieved from the second database (e.g. FIG. 5, #510, pg. 13, ln. 13-20), wherein the first and second databases are used to create the electronic message (e.g. FIG. 5, #518, #520, #522, #524, pg. 13, ln. 22-31).

VI. THE GROUNDS OF REJECTION

The Examiner has rejected all pending claims as follows:

- A. Claim 57 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out or distinctly claim the subject matter which applicant regards as the invention;
- B. Claim 57 stands rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter;
- C. Claims 36-40, 44 and 57-64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,884,032 issued to Bateman, et al. ("Bateman") in view of U.S. Patent No. 5,913,210 issued to Call ("Call"); and
- D. Claims 47-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bateman in view of Call and applicant's allegedly admitted prior art.

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

VII. ARGUMENT

A. 35 U.S.C. § 112, Second Paragraph

Claim 57

Claim 57 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Amendment dated April 6, 2006, if entered by the Examiner, should render the subject indefiniteness rejection moot. If the Amendment dated April 6, 2006 is not entered by the Examiner, then the following arguments are respectfully submitted.

The indefiniteness rejection in the Office Action dated August 2, 2004 recites claim 57 as follows: "A method of purchasing a product, comprising the steps of: providing a first database containing *store* telephone numbers and user information corresponding to each of *the stored* telephone numbers." (emphasis added). The rejection is respectfully traversed.

It is respectfully submitted that the re-typing of the claim in the Office Action dated August 2, 2004 is incorrect. The Applicant respectfully submits that claim 57 was originally presented by way of the Amendment filed September 13, 2002, and was amended by way of the amendment filed September 3, 2003. The Applicant further submits that claim 57, presented in the below Claim Appendix, correctly sets forth: "A method of purchasing a product, comprising the steps of: providing a first database containing *stored* telephone numbers and user information corresponding to each of *the stored* telephone numbers." (emphasis added).

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

In summary, the particular reasons set forth in the Office Action dated August 2, 2004 do not render claim 57 indefinite. Thus, in response to the particular reasons set forth in the Office Action dated August 2, 2004, the indefiniteness rejection should be reversed.

B. 35 U.S.C. § 101

Claim 57

Claim 57 stands rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The non-statutory rejection cites the M.P.E.P., 8th edition, October 2005. Subsequent to the latest revision of the M.P.E.P., the U.S. Patent and Trademark Office issued the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, O.G. Notice, 22 November 2005. In view of the recently issued *Guidelines* the outstanding non-statutory rejection is respectfully traversed.

The *Guidelines* § IV, C, 2, b. set forth that "... the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that *the final result* achieved by the claimed invention is '*useful, tangible and concrete.*'"

Claim 57 particularly sets forth a final result of "... purchasing the product ... based upon the user information ..." It is respectfully submitted that the act of purchasing a product is a useful, tangible and concrete final result. It is further submitted that the burden is on the Examiner to demonstrate why the act of purchasing a product is not a useful, tangible and concrete result. It is respectfully submitted that the Examiner has not sustained his burden.

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

Further, the Office Action dated August 2, 2004 is confusing and self-contradictory on its face. On page 4, ln. 3-6, the Office Action asserts that claim 57 is "not statutory because they *merely recite a number of computing steps.*" However, the Office Action then asserts that "The *use of a computer has not* been indicated." Clearly, claim 57 without said computer use may cover the practical application of non-computer purchases. It is respectfully submitted that the Examiner has not sustained a *prima facie* case that "purchasing" is not a practical application and is not useful, tangible and concrete.

Claim 57 is not merely a number of computing steps without producing any tangible result and/or practical application. Appellant strongly disagrees with this allegation, and the claim itself contains abundant "real world" non-computing steps and produces a tangible result.

Under current law, the claimed invention as a whole must accomplish a practical application. In other words, the claim must produce a "useful, concrete and tangible result." State Street Bank Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601-02. Claim 57 recites a "method of purchasing a product," a concrete, tangible result.

Claim 57 also recites providing a first and second database containing various data including identification codes and "receiving a telephone call from a user including one of the identification codes." The step of receiving a telephone call from a user requires a person to perform some action outside the computer. Furthermore, claim 57 recites "purchasing a product" based upon retrieved information. Thus, the claimed invention achieves a useful, concrete and tangible result – buying a product. Since this claim contains pre and post-computing real world results, it is directed to statutory subject matter.

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

Accordingly, the rejection of claim 57 under 35 U.S.C. § 101 should be reversed.

C. 35 U.S.C. § 103(a) – Claims 36-40, 44 and 57-64

Claims 36-40, 44

Claims 36-40, 44 and 57-64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,884,032 issued to Bateman, et al. ("Bateman") in view of U.S. Patent No. 5,913,210 issued to Call ("Call"). It is respectfully submitted that the outstanding Office Action fails to set forth a *prima facie* case of obviousness. The outstanding obviousness rejection is respectfully traversed.

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of the prior art must be supported by some teaching, suggestion or motivation in the applied references or in knowledge generally available to one skilled in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support the findings of obviousness. In re Hedges, 783 F.2d 1038, 1041, 228 USPQ, 685, 687 (Fed. Cir. 1986); In re Ehrreich, 590 F.2d 902, 908-909, 200 USPQ 504, 510 (C.C.P.A. 1979).

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

All Claim Elements are Neither Taught nor Suggested

By way of review, Bateman is directed towards a system for use with a live call center using live operators to provide help to a user. When users are surfing the World Wide Web, they frequently have questions best answered by human CDA agents. The invention of Bateman is directed towards the connection between the user with the questions and the agent with the answer and how to effectively provide the answer by allowing both parties to simultaneously view common screen information from the World Wide Web. Call, on the other hand, is directed towards an Internet system that delivers information from the source of a product (manufacturer) to a reseller or consumer.

In rejecting independent claim 36, the Examiner relies on the secondary reference, Call, as allegedly disclosing a method of addressing an electronic message. The Examiner implies that Call discloses a method of addressing an electronic message and refers to column 4, lines 53-57. However, that cite merely refers to an email confirmation that may be requested. There is no teaching or suggestion at that cite or within Call which discloses a method for actually addressing an email.

Claim 36 recites "providing a first database containing stored telephone numbers and user addresses corresponding to each of the stored telephone numbers" (although the Examiner substitutes "user information" for "user addresses"). The Examiner alleges that Call discloses this feature as well and cites column 5, lines 3-12, which references Fig. 2. This section of Call and Fig. 2 deals with an incoming registration template 207 used to create records. Nowhere in

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

that cite or on Fig. 2 is there a suggestion of storing telephone numbers and user addresses corresponding to each of the stored telephone numbers.

The Office Action refers to Call and includes specific column and line cites. However, some of the text referring to disclosed reference numerals appear to indicate that the Examiner might be referring to Bateman instead of Call. If this is correct, the first allegation that Bateman discloses a method of addressing an electronic message as disclosed on column 4, lines 53-57, is in error. Column 4, lines 53-57 of Bateman does not have anything to do with an electronic message. Turning to column 5, lines 3-12 of Bateman, this section of Bateman discusses generation of an URL of the organization's product and service database. There is no mention of stored telephone numbers or user addresses in this database as specifically recited in the claim.

The Examiner points to an agent workstation computer 18 as set up to preview HTML pages associated with the caller's URL before or while an outbound call is being made (column 6, lines 48-50) as reading on the claimed feature "providing a second database containing identification codes and product information corresponding to each of the identification codes." This cite apparently refers to Bateman. However, a thorough look at the cite shows that it merely discloses a workstation computer 18 that can access an HTML page when provided with a URL. This is a far cry from a second database containing identification codes and addressing information corresponding to each identification code.

The Examiner alleges that Bateman teaches addressing the electronic message according to the retrieved address. The Examiner relies on the creation of an HTML form that uses that user's IP address and the URL of interest, citing column 7, lines 1-5. Claim 36 recites providing

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

a first database containing stored telephone numbers and user addresses for each of the stored telephone numbers. Upon receiving a telephone call from a user, the user address for that telephone number as stored in the first database is retrieved and the stored user address for that telephone number is used to address the electronic message. The Bateman system operates differently. In the Bateman system as disclosed, the user visits a company's URL. If the user requires help, the user's IP address is sent to an agent's IP address with the URL that the user is seeking help on. Once the agent receives the user's IP address and URL, an outbound Internet call is set up to the IP address of the user and the agent uses the URL of interest to view the same page as the user during the call. As stated earlier, Bateman does not disclose a database containing stored telephone numbers paired with user address information related to each of those telephone numbers. In addition, the cited portions of the specification deal with an alternative to using the user's telephone number. In this alternative, a call is placed over an Internet network as opposed to the public switch telephone network. The Bateman system does not store any telephone number for a user paired with the user's address information for subsequent use to address an electronic message. In Bateman, when a user requires help, he submits his IP address and URL of interest, which is then transmitted to the Bateman system. The Bateman system takes this information to either make a telephone call to the user over the PSTN or, as alternatively described at the beginning of column 7, placing an Internet call using the IP address just received from the user. It becomes quickly apparent by looking at the cites relied upon in the Office Action that the Examiner is attempting to use key words similar to the recited element names out of context for each individual limitation.

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

The Examiner does recognize that Bateman does not disclose sending at least a portion of the retrieved product information via an electronic message wherein the first and second databases are used to create the electronic message (the Examiner improperly refers to "user information" in the Office Action as opposed to "product information"). The Examiner attempts to overcome this by claiming that Call discloses "supplied as all or part of the email message sent to that address, enabling the manufacturer to identify the specific product (see column 7, lines 10-30)(sic)." A more thorough review and understanding of Call shows that Call deals with a situation wherein a product code is entered by a user and sent to a central station. The central station contains a single database wherein an email address is associated with that product code. The central station therein uses a SMTP forwarding agent to forward the received email to the email address designated by the product code. The email address associated with the code in Call has nothing to do with the user. The email address in Call is the email address of the manufacturer who manufactures the product identified by the code. Thus, Call does not have anything to do with addressing an email to a user. Call is merely an automated forwarding agent where an email is forwarded to someone other than the user.

Furthermore, the Examiner explicitly acknowledges that the combined teachings of Bateman and Call, as inappropriately understood and applied, still requires further modification to render the claim obvious. The Examiner alleges that it would have been obvious to one of ordinary skill to modify the combined teachings of Bateman and Call to arrive at the step of sending at least a portion of the retrieved user information via the electronic message and wherein the first and second databases are used to create the electronic message. The Examiner's

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

rationale is that such a modification would allow the teachings of Bateman and Call to provide facilitating (sic) of the transfer of information about products from manufacturers or suppliers to resellers, customers and any others who need or desire that information. Appellant contends that the Examiner is engaging in improper hindsight reasoning that such a modification would be obvious. Absent the Appellant's own disclosure, there is no motivation or suggestion that such a further modification of Bateman and Call is possible or even preferable. The Examiner relies on a statement in Call saying it is the principle object of the Call invention to facilitate the transfer of information and thus, the Appellant's chosen method of facilitating the transfer of information would have been obvious, even though neither Bateman nor Call recognizes or suggests taking this particular route to achieve that goal.

No Evidence in Support of Combination of References

To establish obviousness based on the combination of elements disclosed in the prior art there must be some motivation, suggestion or teaching, and the desirability of making the specific combination that was made by the Appellant. The motivation, suggestion or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill in the art or, in some cases, the nature of the problem to be solved. In re Dembiczak, 50 USPQ2d. 1614 (Fed. Cir. 1999). In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See Dembiczak, 50 USPQ2d at 1617. Broad conclusionary statements standing alone are not "evidence."

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

In the Office Action dated August 2, 2004, the Examiner attempts to combine Call with the teaching in Bateman to overcome the deficiencies in Bateman. Further, after combining Bateman and Call, the Examiner further modifies this combination in an attempt to render the claims obvious. For example, in the rejection identified above, the Examiner recognizes that Bateman does not disclose sending at least a portion of the retrieved user information via an electronic message, wherein the first and second databases are used to create the electronic message. This is due in part because Bateman is directed towards a *live help* function for Internet browsing. The Examiner turns to Call for this alleged teaching. However, the Examiner does not provide any reasoning as to why someone of ordinary skill in the art would recognize or be motivated to combine any teachings within Call with the basic system of Bateman. In addition, the Examiner goes further and says it would have been obvious to modify the combined teachings of Bateman and Call to arrive at the claimed invention because such a modification would make a better product. Appellant submits that this is improper hindsight reconstruction, and the Examiner has failed to provide any support for making the particular combination, whether such combination would result in an operable invention, or motivation on why the combination should be further modified to achieve the invention claimed. Accordingly, Appellant respectfully submits that the § 103 rejection should be reversed because the Examiner has failed to make a *prima facie* case of obviousness, particularly as it relates to the combinability of the references chosen or further modification of that combination.

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

Claims 57-64

Claim 57 is similar to claim 36. Therefore, the arguments set forth above with regard to claim 36 are herein incorporated by reference.

However, claim 57 further recites the first database contains user information and the step of purchasing the product based upon the user information retrieved from the first database and the product information retrieved from the second database, wherein the first and second databases are used to create the electronic message. The Examiner acknowledges that Bateman does not disclose the steps of purchasing the product based on user information retrieved from the first database and the product information retrieved from the second database. The Examiner attempts to overcome this deficiency by alleging that Call disclosing steps of providing shared computer services which interoperates with a reseller's inventory control system to provide customers with the information they desire before and after making purchases while citing column 12, lines 36-40. The Examiner does not provide a reasoning as to why this particular portion of Call would be or should be combined with Bateman. In addition, Call does not disclose or suggest the actual purchase of a product using the information retrieved from the databases, and particularly not at the location cited by the Examiner. This portion of Call merely alludes to the possibility that an Internet service provider can help a reseller control inventory by replacing products that are purchased in the traditional fashion by a customer. However, this is different from alleging that the combined teachings would render obvious the step of purchasing a product based upon user information retrieved from a first database and the product information retrieved from a second database wherein the first and second databases are used to

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

create the electronic message. The Examiner does allude to the fact that the combined teachings of Bateman and Call would still require further modification to arrive at the claimed invention. To overcome this recognized deficiency, the Examiner once again engages in impermissible hindsight reasoning to suggest that such a modification is suggested by the goal of facilitating the transfer of information, as alluded to in Call, and would have been obvious, even though it is only disclosed in the application. Accordingly, the rejection of claims 36-40, 44 and 57-64 under 35 U.S.C. § 103 over Bateman in view of Call should be reversed.

D. 35 U.S.C. § 103(a) - Claims 47-56

Claims 47-56

Claims 47-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bateman in view of Call and applicant's allegedly admitted prior art. The outstanding obviousness rejection is respectfully traversed.

The Office Action dated August 2, 2004 alleges that Bateman and Call teach the basics of claim 47 as discussed with respect to claim 36, but further relies on some alleged "admitted prior art" in the application. The Examiner cites the application at page 1, line 34 to page 2, line 35. However, a full reading of that background section clearly shows that the Appellant alleged there was *not* any system the Appellant was aware of that performs this action.

It is respectfully submitted that the Examiner has misunderstood the specification and thought the Applicant was saying there is such a system. Since the Examiner acknowledges that the claim recites features not disclosed except in the allegedly admitted prior art, and a careful

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

reading of the application shows that there was no admission of prior art, the rejection as applied should not stand. Thus, it is respectfully submitted that the Examiner has not sustained the burden of presenting a *prima facie* case as applied to claims 47-56.

Furthermore, Appellant reasserts the arguments with respect to claim 36 and submit that the combination of Bateman and Call is inappropriate, and even if appropriate, fails to teach or suggest the invention claimed.

In the Office Action, the Examiner lumps claims 47 and 56 together without referring to specific features of either claim. Therefore, the rejection with respect to claim 56 should also not stand for the reasons given with respect to claim 47. Accordingly, the rejection of claims 47-56 under 35 U.S.C. § 103 over Bateman in view of Call and applicant's allegedly admitted prior art should be reversed.

VIII. CONCLUSION

For the reasons specifically set forth above, the outstanding rejection set forth in the Office Action should be reversed.

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
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Application No.: 09/545,088
Attorney Docket No.: CGH 3001

CLAIMS APPENDIX

1-35. Cancelled.

36. A method of addressing an electronic message, comprising the steps of:

providing a first database containing stored telephone numbers and user addresses for each of the stored telephone numbers;

providing a second database containing identification codes and product information corresponding to each of the identification codes;

receiving a telephone call from a user including one of the identification codes;

identifying the received telephone number from the telephone call;

retrieving the user address from the first database by comparing the received telephone number with the stored telephone numbers;

retrieving the product information corresponding to the received identification code;

addressing the electronic message according to the retrieved address; and

sending at least a portion of the retrieved product information via the electronic message, wherein the first and second databases are used to create the electronic message.

37. The method as recited in claim 36, wherein the electronic message is a fax.

38. The method as recited in claim 36, wherein the electronic message is an e-mail.

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

39. The method as recited in claim 36, wherein the electronic message is a voice mail.
40. The method as recited in claim 36, wherein the user information includes payment instructions and the payment instructions are sent via the electronic message.
44. The method as recited in claim 36, wherein the electronic message includes an advertisement or an order confirmation.
47. A system for addressing an electronic message, comprising:
- a first database containing stored telephone numbers and user information corresponding to each of the stored telephone numbers;
 - a second database containing identification codes and addressing information corresponding to each of the identification codes;
 - a receiver for accepting a telephone call from a user including one of the identification codes;
 - an ANI for identifying the received telephone number from the telephone call;
 - a processor; and
- wherein the first and second databases are used to create the electronic message and the processor retrieves the user information from the first database by comparing the received telephone number with the stored telephone numbers, retrieves the addressing information

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

corresponding to the received identification code, addresses the electronic message according to the retrieved addressing information, and sends at least a portion of the retrieved user information via the electronic message.

48. The system of claim 47, wherein the electronic message is a fax.

49. The system of claim 47, wherein the electronic message is an e-mail.

50. The system of claim 47, wherein the electronic message is a voice mail.

51. The system of claim 47, wherein the user information includes payment instructions and the payment instructions are sent via the electronic message.

52. The system of claim 47, wherein the user information includes a user address and the user address is sent via the electronic message.

53. The system of claim 52, further including a second processor and wherein the second processor retrieves the user address from the electronic message.

54. The system of claim 53, wherein the second processor sends a second electronic message to the user.

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

55. The system of claim 54, wherein the second electronic message includes an advertisement.

56. A method of addressing an electronic message, comprising the steps of:

providing a first database containing stored telephone numbers and corresponding payment instructions and user addresses;

providing a second database containing identification codes and addressing information corresponding to each of the identification codes;

receiving a telephone call from a user including one of the identification codes;

identifying the received telephone number from the telephone call using an ANI;

retrieving the user information from the first database by comparing the received telephone number with the stored telephone numbers;

retrieving the addressing information corresponding to the received identification code;

addressing the electronic message according to the retrieved addressing information; and

sending the payment instructions via the electronic message, wherein the first and second databases are used to create the electronic message.

57. A method of purchasing a product, comprising the steps of:

providing a first database containing stored telephone numbers and user information corresponding to each of the stored telephone numbers;

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

providing a second database containing identification codes and product information corresponding to each of the identification codes;

receiving a telephone call from a user including one of the identification codes;

identifying the received telephone number from the telephone call;

retrieving the user information from the first database by comparing the received telephone number with the stored telephone numbers;

retrieving the product information corresponding to the received identification code; and

purchasing the product based upon the user information retrieved from the first database and the product information retrieved from the second database, wherein the first and second databases are used to create the electronic message.

58. The method as recited in claim 57, wherein user information includes address information.

59. The method as recited in claim 58, wherein address information includes shipping information.

60. The method as recited in claim 58, wherein address information includes billing information.

61. The method as recited in claim 57, wherein user information includes payment instructions

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

62. The method as recited in claim 61, wherein payment instructions include credit card information

63. The method as recited in claim 57, further comprising the step of shipping the product.

64. The method as recited in claim 59, wherein shipping information includes delivery method information

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

EVIDENCE APPENDIX

Listing and copies of evidence relied upon by the Examiner as to grounds of rejection to be reviewed on Appeal:

1. U.S. Patent No. 5,884,032 issued to Bateman, et al. ("Bateman").
2. U.S. Patent No. 5,913,210 issued to Call ("Call").

Application No.: 09/545,088
Attorney Docket No.: CGH 3001

RELATED PROCEEDINGS APPENDIX

None.

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